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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,753	12/13/2004	Richard L Andrews	5468-102US/P28047-A-USA	1334

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EXAMINER

PAULA, CESAR B

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Office Action Summary</p>	<p>Application No.</p> <p>10/517,753</p>	<p>Applicant(s)</p> <p>ANDREWS ET AL.</p>	
	<p>Examiner</p> <p>CESAR B. PAULA</p>	<p>Art Unit</p> <p>2178</p>	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-10,14-18 and 22-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 6-10, 14-18, and 22-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____.</p> |
|---|--|

DETAILED ACTION

1. This action is responsive to the amendment filed on 1/31/2006.

This action is made Final.

2. In the amendment, claims 3-5, 11-13, and 19-21 have been canceled. Claims 25-27 have been added. Claims 1-2, 6-10, 14-18, and 22-27 are pending in the case. Claims 1, 9, and 17 are independent claims.

Priority

3. Acknowledgment is made of applicant's claim for domestic priority under 35 U.S.C. 119(e), and based on U.S. provisional application # 60/390,098 filed on 6/19/2002.

Drawings

4. The drawings filed on 12/13/2004 have been accepted by the Examiner.

Claim Objections

5. Claims 1-2, 6-10, 14-18, and 22-27 are objected to because of the following informalities:
“thereby automatic creation” in lines 28, 27, and 27 respectively. This phrase better reads as
“thereby automatic creating” Appropriate correction is required.

6. Claim 27 is objected to for reciting “the method of claim 17”. Claim 17 is directed to a computer program product, and not a method.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-2, 6-10, 14-18, and 22-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1, 9, and 17 recite "enhanced HTML pages, containing said source HTML files", "enhanced HTML pages, containing said source HTML file", "enhanced HTML pages, containing said source HTML files", in lines 24-25, 22-23, and 23 respectively. The Examiner failed to find in the instant specification enhanced pages containing HTML files. What is well known in the art, is the inclusion of HTML web pages within HTML source files. The specification does not support the citation in the claims.

9. Claims 1, 9, and 17 recite the limitation "said template specifying characteristics of the visual appearance of the electronic document adjacent to said source HTML file" in lines 18-19. The Examiner has failed to find an explanation as to how one of ordinary skill in the art would accomplish the placement of the characteristics next to the source file.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-2, 6-10, 14-18, and 22-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. Claims 1, 9, and 17 recite the limitation "said HTML file" in line 19. There is insufficient antecedent basis for this limitation in the claim. The claims recite a series of HTML files prior to the quotation above. It is unclear to which of the files the recitation above is referring.

13. Claims 1, 9, and 17 recite the limitation "said template specifying characteristics of the visual appearance of the electronic document adjacent to said source HTML file" in lines 18-19. There is insufficient antecedent basis for this limitation in the claim. The claims recite a series of HTML files prior to the quotation above. It is unclear to which of the files the recitation above is referring. It is uncertain as to what this statement means. It appears to say that the characteristics of the document are located next or adjacent to the HTML file. It is not clear where the characteristics are, whether there is another file that contains the characteristics.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1-2, 6-10, 14-18, and 22-27 remain rejected under 35 U.S.C. 102(b) as being anticipated by DeRose et al, hereinafter DeRose (Pat.# 6,167,409, 12/26/2000).

Please find the rejection of the pending claims below in light of the 35 USC 112 rejections above.

Regarding independent claim 1, DeRose teaches the creation and generation of markup language documents, such as HTML, which contain cross-referencing links--hierarchical navigational elements-- and linear navigational elements, such as table of contents, bookmarks, etc (col. 7, lines 3-30, col. 8, lines 17-38, and col.11, lines 15-62, col.13, lines 57-67).

Moreover, DeRose teaches a computer system for the creation and generation of markup language documents in a table of contents organization, from a source documents--books, manuals, etc, in a format such as SGML, into another target format, such as HTML. The table of contents is used for downloading the document is section--*series of HTML files*-- (col. 7, lines 3-30, and 40-67, col.11, lines 4-67).

Moreover, DeRose teaches the automatic creation of a tree representing a hierarchical relationship between the markup document and its elements--*at least two hierarchical levels established*. The tree divides the document up into many sections, subsections, etc--page nodes which are arranged into a sequential ordering in the same order as that of a printed manual. — *a source document, intended for printed publications, comprising sequentially numbered*

source pages; said sequential ordering relating each of said source HTML files in the same order as said corresponding, sequentially numbered source pages of said source document (col. 8, lines 1-67, col.7, lines 58-67, and fig.3-4).

Moreover, DeRose teaches the creation, and storing of a stylesheet(s)-- *a means for storing said templates--* for describing the display format of the documents. The stylesheet has code, such as “#header” for inserting information into web pages-- *a templatier means for defining a template, said template specifying characteristics of the visual appearance of the electronic document adjacent to said source HTML file, said template comprising at least one document layout elements, said layout out elements comprising at least one substitution code (col. 13, lines 21-col.16, line 67).*

Furthermore, DeRose teaches the conversion of the source SGML documents into HTML documents, and the rendering in a client computer system using the stylesheets, the code, and the documents hierarchical relationships. The code is use for the substitution of the codes with information for paginating (in a sequential manner) the document pages, which are downloaded using links presented in a hyperlinked table of contents-- *a rendering means for creating final, static enhanced HTML pages, containing said source HTML files, to be displayed, said rendering means employing said template, said hierarchical relationships, said document layout elements and said source HTML files, and wherein said hierarchical substitution code is automatically rendered by said rendering means as a string sequentially identifying all of said pages nodes having a like hierarchical substitution code, thereby automating creation of an electronic document that is representative of said source document suitable for incorporation in a web-site. (col. 7, lines 3-67, col.11, lines 4-14, col. 13, lines 24-*

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67, and col.17, lines 26-67).

Regarding claim 2, which depends on claim 1, DeRose teaches a computer pointer device or mouse, which as was well known in the art is used for dragging and dropping document objects (col. 7, lines 30-67).

Regarding claim 6, which depends on claim 1, DeRose teaches the translation, and rendering of the converted or final documents is done over WWW--*Internet*-- (col. 7, lines 3-41).

Regarding claim 7, which depends on claim 6, DeRose teaches the rendering of the converted or final documents is done using a browser--*Internet reader* (col. 7, lines 16-30).

Regarding claim 8, which depends on claim 1, DeRose teaches the rendering of structured documents, such as manuals, electronic books (col. 7, lines 16-30, 57-67).

Claims 9-10, 14-16 are directed towards a method for implementing the steps found in claims 1-2, 6-8 respectively, and are therefore similarly lack novelty.

Claims 17-18, 22-24 are directed towards a computer program product for storing, and implementing the steps found in claims 1-2, 6-8 respectively, and are therefore similarly lack novelty.

Regarding claim 25, which depends on claim 1, DeRose teaches the conversion of the source SGML documents into HTML documents into table of contents using the documents hierarchical relationships -- *said source document further comprises a table of contents and wherein said hierarchical relationships correspond to said table of contents* (col. 7, lines 3-67, col.11, lines 4-14, and col.17, lines 10-67).

Claims 26-27 are directed towards a method for implementing the system found in claim 1, and are therefore similarly rejected.

Response to Arguments

16. Applicant's arguments filed 1/3/2006 have been fully considered but they are not persuasive. Regarding claims 1, 9, and 17, the Applicant submits that "the Office Action does not show where DeRose teaches a template that specifies characteristics of the visual appearance of the electronic document adjacent to said source HTML file, where the source HTML file is representative of the source page of the document intended for publication, DeRose does not anticipate applicants' invention of claim 1,the Office Action does not show where Delkose teaches using an hierarchical substitution code that is automatically rendered as a string that sequentially identifies all pages that have the same hierarchical substitution code, so as to help in automatically creating an electronic document that is representative of the source document and is suitable for incorporation in a web-site." (page 9). As indicated above, the underlined language is vague, and necessitates more clarification. Nevertheless, DeRose teaches the creation, and

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storing of a stylesheet(s)-- *a means for storing said templates--* for describing the display format of the documents. The stylesheet has code, such as “#header” for inserting information into web pages-- *a templatel means for defining a template, said template specifying characteristics of the visual appearance of the electronic document adjacent to said source HTML file, said template comprising at least one document layout elements, said layout out elements comprising at least one substitution code* (col. 13, lines 21-col.16, line 67).

Claims 2, 6, 8-10, 14-16, 18, and 22-27 depend on claims 1, 9, and 17, therefore are rejected at least based on the rationale established above.

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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I. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The Examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.


Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://portal.uspto.gov/external/portal/pair>. Should you have any questions about access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866 217-9197 (toll-free).

Any response to this Action should be mailed to:
Commissioner for Patents
P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

- (571)-273-8300 (for all Formal communications intended for entry)


CESAR PAULA
PRIMARY EXAMINER
4/17/06